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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,380	02/26/2004	Brad L. Grande	2-1	4270
47386 7590 04/04/2012 RYAN, MASON & LEWIS, LLP 1300 POST ROAD SUITE 205 FAIRFIELD, CT 06824				
EXAMINER BUI, HUNG S				
ART UNIT 2835		PAPER NUMBER		
MAIL DATE 04/04/2012		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/787,380

**Applicant(s)**

GRANDE ET AL.

**Examiner**

Hung S. Bui

**Art Unit**

2835

**Period for Reply** -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2012.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-20 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-20 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 04/19/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 01/23/2012, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Jinhee J Lee/  
Supervisory Patent Examiner, Art Unit 2835

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-11, 13-17 and 19-20 are rejected under 35 U.S.C. 102(b) as anticipated Ito et al. [US 2001/0007524].

**Regarding claims 1 and 14,** Ito et al. disclose a modem module (31, figure 1a) for connecting to a carrier assembly/printed circuit board (30, figure 1a, paragraph 0003, lines 10-13, modem module is connected to and provided on carrier assembly) comprising circuitry (modem 31 inherently has circuitry provided to perform its intended function) for interfacing with a telephone line (modem connector 32 provides interface with telephone line, figure 1a) and one or more solder pads for connecting a signal line of said modem module to the carrier assembly (paragraph 003, lines 10-13, modem module is soldered to the carrier assembly, the soldering of the modem module provides solder pads, the functional limitation that the solder pads are for connecting a signal line of the modem module to the carrier assembly/circuit board is fully met as the solder pads enable the modem module to be physically and electrically connected to the carrier assembly/printed circuit board in order for the device to operate as intended. Soldering connects the modem module with the modem connector 32 and electrical connections/traces necessarily provided on the carrier assembly/printed circuit board to electrically interconnect these components together. The solder pads allow the modem module to be physically secured to the carrier assembly/circuit board and also provide the function of allowing the electrical connection of a signal line of the modem module to the carrier assembly so that the modem module is electrically connected to the carrier assembly/printed circuit board.)

**Regarding claims 2-3 and 15-16,** Ito et al. disclose a tip/ring connector (32, figure 1a) for interfacing with the telephone line.

**Regarding claims 4 and 17,** Ito et al. disclose the carrier assembly being a motherboard (30, figure 1a).

**Regarding claims 6-7 and 19-20,** Ito et al. disclose the modem assembly being an integrated device and being fabricated on a printed circuit board (figure 1a).

**Regarding claims 8-11 and 13,** the claim method steps are inherit in the product structures.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. in view of Downie et al. [US 5,471,368].

**Regarding claims 5 and 18,** Ito et al., disclose the instant claimed invention but does not provide detail of the one or more solder pads being soldered to corresponding one or more solder pads on the carrier assembly.

Downie et al. disclose an expansion board (110, figures 3-5) soldered onto a mother board (20, figure 5) through a plurality of solder pads which are corresponding therefrom the expansion board and the mother board (53, 55, 63, 65, figure 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to solder the modem card onto the mother board of Ito et al., as suggested by Downie et al., for the purpose of providing complete electric circuit and conducting paths between the modem and the motherboard.

**Regarding claim 12**, the claim method steps would have been necessitated by the product structures.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Belopolsky et al. [US 7,052,329] disclose electrical connector with an internal modem; and

- Expensshade et al. [US 6,896,553] disclose electrical connector with an integrated modem.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG S. BUI whose telephone number is (571)272-2102. The examiner can normally be reached on Monday-Friday 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee J. Lee can be reached on (571) 272-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/  
Supervisory Patent Examiner, Art Unit 2835

/Hung S. Bui/  
Primary Examiner, Art Unit 2835  
03/27/2012